

## **REMARKS**

Claims 1-70 are pending in the above-identified application and have been subjected to restriction by the Office Action under 35 U.S.C. §121 as follows:

- I. Claims 1-10, 35, 62-63, and 68, drawn to tertiary amide, classified in claim 554, subclass 35.
- II. Claims 11-24, 26-34, 36-39, 56-60, and 64-67, drawn to pharmaceutical compositions and method of making/using them, classified in class 514, subclass 563.
- III. Claim 25, drawn to a method of killing microorganisms, classified in Claim 504, subclass 300.
- IV. Claims 42-55 and 69-70, drawn to preparing ether and compounds thereof, classified in class 568, subclass 449.

In support of the present Restriction Requirement, the Office Action has alleged that Groups I-IV are distinct, alleging that the subject matter in Groups II-IV and I are unrelated.

As indicated hereinabove and in order to be fully responsive to the requirement for restriction imposed by the Office Action, applicants provisionally elect, with traverse, to prosecute the subject matter of Group I, i.e., Claims 1-10, 35, 62, 63 and 68 for continued examination herein.

In addition, applicants reserve the right to file a divisional application directed to the non-elected subject matter.

Notwithstanding the foregoing, applicants hereby traverse, pursuant to 37 C.F.R. §§1.111 and 1.143, the requirement for a restriction and request reconsideration thereof in view of the following remarks.

Applicants respectfully request that the Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141 and 1.142. 35 U.S.C. §121 provides that the Commissioner may restrict an application when two or more independent and distinct inventions are claimed in a single application (emphasis added). Similarly, 37 C.F.R. §1.141(a) permits restriction on condition that independent and distinct inventions are found within one application. Only the statutory requirement that the various groups of claims are “distinct” has been proffered as a basis for requiring the restriction. Even assuming, pro arguendo, that the Office Action was correct with respect to distinctiveness, there is absolutely no indication in the Office Action that Groups I-IV are also independent.

Consequently, because the Office Action has not even alleged the statutory required “independence” of these groups, the Office Action has not maintained its burden respecting the Restriction Requirement. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein, so as to encourage applicants to provide a more detailed disclosure of all aspects of their invention. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner recognized by 35 U.S.C. §112, all aspects as to what they regard as their

invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of applicants' financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), the applicants are required to either conduct simultaneous prosecution with attendant filing fees and costs or face a compromise of the term of their patent assets.

It is vital to all applicants that Restriction Requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double-patenting. The third sentence of U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention-double-patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement.

Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect patentee's rights and to serve the public's interest in the legitimacy of issued patents, applicant respectfully urges the Examiner not to require restriction in cases such as the present application.

The Office Action also seems to suggest that a prior art search requiring search in more than one classification is sufficient criteria for maintaining a restriction to allegedly different patentable inventions. This, of course is error. It simply does not comply with the provisions under 35 U.S.C. §121. (See In re Kuehl, *supra*).

The classification system is an unreliable basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent an Examiner from basing patentability decisions, as to claims he assigned to one group, on patent references found in the subclass(es) with which he associated another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem

largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications is “independent and distinct” as those terms are used in 35 U.S.C. §121, which fact proves that basing restriction requirements on the classification system is improper.

Hence, it is respectfully requested that the United States Patent and Trademark Office reconsider and withdraw the requirement for restriction pursuant to 35 U.S.C. §121 and provide an action on the merits with respect to all of the claimed subject matter.

Applicants also request clarification of the restriction requirement. In reviewing the restriction requirement it is noted that Claims 40, 41 and 61 have not been assigned to any of the groups. Clarification thereof is respectfully requested.

Applicants are also enclosing an amendment to the claims. This amendment corrects the dependencies of some of the claims. In addition, it corrects the punctuation of Claim 3 and amends with greater particularity the subject matter of Claim 29. Further, Claim 30 has been amended to be consistent with the claim upon which it is dependent.

No new matter is added to the application. Moreover, these amendments to the claims do not narrow the scope thereof.

However, based on the amendments, to clarify the record, especially if the traversal is unsuccessful, the grouping of the claims in the Office Action should be modified. For example, Claim 36 is now dependent on Claim 35. According to the Restriction requirement, Claim 35 is in Group I, while Claim 36 is in Group II. It is respectfully requested that Claim 36, in view of the Amendment, should be designated in Group I to be consistent with the Restriction Requirement imposed.

It is respectfully submitted that in view of the amendment to the claims and the Remarks herein, the present application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark J. Cohen". The signature is fluid and cursive, with the first name "Mark" being the most prominent.

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